

Remarks:

This application has been reviewed carefully in view of the Office Action mailed September 27, 2004, ("the Office Action"). In the Office Action, the specification was 5 objected to under 35 U.S.C. § 112, first paragraph as failing to support the subject matter set forth in the claims. Claims 1 to 9 and 16 to 34 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 1 to 10 9 and 16 to 34 were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 to 6, 17, 29, 31 and 34 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Pool et al., US Patent 6,460,020 B1. Claims 7 to 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pool et 15 al. in view of Dutta et al., U. S. Publication No. 2003/0061058 A1.

The above-described objections and rejections are addressed as follows:

I. AMENDMENTS TO THE SPECIFICATION

20 In a substitute specification, the applicants have amended the specification to incorporate text from a PCT patent application, entitled "Methods of Creating Electronic Customs Invoices", Application Serial Number US01/30687, filed in the US Receiving Office on October 1, 2001, which is incorporated by reference in the present application 25 on page 40, lines 5-8 (as amended on page 3 of the Amendment filed November 7, 2003). For the convenience of the examiner, the applicants note the following portions of the PCT patent application, from which support may be found for the incorporated text:

30 The text of the Substitute Specification from page 1, line 20, to page 2, line 27, is supported in US01/30687, from page 1, line 15, to page 2, line 27.

The text of the Substitute Specification from page 38, line 19 to page 39, line 15, is supported in US01/30687, from page 8, line 3, to page 9, line 4.

In addition to the above incorporation of text, the applicants note the following correction of a typographical error on page 38, line 10: "take into account both the ~~best~~ best practices and legal requirements of each country". This typographical error would clearly be recognized as such by a person skilled in the art, and the correction would likewise be clear to a person skilled in the art.

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No new matter was added with any of the Amendments.

10 II. REJECTION UNDER 35 U.S.C. § 112, FOR INDEFINITENESS

Claims 1 to 9 and 16 to 34 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 34 have been amended to recite "receiving the buyer's authorization" to overcome this rejection, as agreed upon in a telephonic interview with the examiner on February 3, 2005.

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20 III. OBJECTION TO THE SPECIFICATION AND REJECTION OF THE CLAIMS
UNDER 35 U.S.C. § 112, THE WRITTEN DESCRIPTION REQUIREMENT

In the Office Action, the specification was objected to under 35 U.S.C. § 112, first paragraph as failing to support the subject matter set forth in the claims. Additionally, claims 1 to 9 and 16 to 34 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (i.e., the written description requirement). The applicants note with appreciation that in the telephonic interview on February 3, 2005, the examiner clarified that the objection and related rejection were based only on the written description requirement, and not on the enablement requirement as suggested in the Office Action.

A. Claims 1, 30 and 34 Meet the Written Description Requirement

Throughout its sections, the specification describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The applicants therefore respectfully traverse the objection and the related rejection of claims 1, 30 and 34. More particularly, the applicants traverse that the specification does not contain a written description of "customs invoice information, which is additional to information on documents typically in transit with purchased goods", and that the specification does not contain a written description that "the brokering party receives the customs invoice information separately from documents accompanying the goods."

In the Background of the Invention, the specification identifies as a problem that "a large corporation with thousands of buyers and sellers world wide can have extreme variation in its practices. This potentially leads to noncompliance or inconsistent compliance with various national laws, excessive delivery times, additional expenses in customs, shipping and brokering, and unclaimed drawbacks from refundable duties." Furthermore, "A noncompliance with national laws is particularly important, as it can lead to both extreme financial penalties and the arrest and incarceration of people ignorantly conducting transactions violating the law." [See, substitute specification, page 3, lines 11-20.]

In describing features of the invention, the Summary of the Invention recites a step wherein "[t]he server then . . . transmits customs invoice information to a customs broker." [See, substitute specification, page 6, lines 7-9.] The Summary of the Invention further recites that using such features "provides for consistent and predictable transactions that safely meet various legal requirements on a consistent basis." [See, substitute specification, page 6, lines 14-16.]

The Background therefore makes clear that the documents normally in transit with shipments do not provide brokering parties with adequate information to maintain consistency between the many transactions conducted by a large corporation, while the Summary of the Invention makes clear that the transmission of customs invoice

information to brokering parties does provide brokering parties with adequate information to maintain consistency between the many transactions conducted by a large corporation. From this, a person skilled in the art would recognize that the inventors understood their invention to include the concept of the transmission of customs invoice information to a brokering party, separately from the documents accompanying the goods, and including information additional to information on documents typically in transit with purchased goods.

Moreover, in the Detailed Description of the Preferred Embodiments, the specification reenforces these concepts. More specifically, the specification recites that "[t]he import functional engine includes service engines having functionality to take care of import issues in one or more jurisdictions. One typically important import issue is the handling of imported goods through customs, whether by the client themselves or a third party customs broker. Central to the import process is the proper description and classification of goods. Also, of high importance are the consistent description and classification of goods." [See, substitute specification, page 37, line 23 to page 38, line 2.]

The specification goes on to recite that "[t]o manage these issues effectively, the import functional engine preferably includes one or more service engines that generate, or assist in the generation of, customs invoices that consistently and accurately describe the products." "The service engines also preferably account for any assists that are to be claimed during import, such as is described above with regard to the export functional engine. The service engines deliver the customs invoice information to the appropriate broker or company representative in the import jurisdiction." [See, substitute specification, page 38, lines 7-15.]

The Detailed Description therefore again reenforces the disclosure of the Summary of the Invention, making clear that the transmission of customs invoice information to brokering parties does provide brokering parties with adequate information to maintain consistency between the many transactions conducted by a large corporation. This further supports that a person skilled in the art would recognize that the inventors understood their invention to include the concept of the transmission of customs invoice information to a brokering party, including information in addition to information on documents typically

in transit with purchased goods (which do not provide brokering parties with adequate information to maintain consistency, as discussed above).

B. Claim 16 Meets the Written Description Requirement

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The specification further describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention of claim 16. The applicants therefore respectfully traverse that objection and the related rejection. More particularly, the applicants traverse 10 that the specification does not contain a written description of "the customs invoice information includes information generated based on customs requirements of the country for which the brokering party is brokering the goods."

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As noted above with respect to claim 1, the Background makes clear that the 15 documents normally in transit with shipments do not provide brokering parties with adequate information to maintain consistency between the many transactions conducted by a large corporation; the Summary of the Invention makes clear that the transmission of customs invoice information to brokering parties provides brokering parties with adequate information to maintain consistency between the many transactions conducted by a large 20 corporation; and a person skilled in the art would recognize the invention to include the transmission of customs invoice information to a brokering party, including information additional to that found on documents typically in transit with purchased goods.

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Furthermore, the specification explicitly recites that "the import functional engine 25 preferably includes one or more service engines that generate, or assist in the generation of, customs invoices that consistently and accurately describe the products. Preferably these service engines take into account both the best practices and the legal requirements of each country". [See, substitute specification, page 38, lines 7-11.] From the above recited information, in total with the other information recited in this Amendment, a 30 person skilled in the art would recognize that the inventors understood their invention to include the concept of transmitting customs invoice information including information generated based on customs requirements of the country for which the brokering party is brokering the goods.

Moreover, the specification recites that "the many governments of the world have a variety of ... TLCL requirements in the form of import laws, regulations, rules, best practices and the like to deal with these subjects. These TLCL requirements change frequently." [See, substitute specification, page 32, lines 9-11.] "[T]he application server 5 preferably accesses information on the various TLCL requirements of different countries and different users, to selectively activate the service engines (and portions of service engines) most appropriate to the user's needs." [See, substitute specification, page 30, lines 23-26.]

10 From this additional information, in total with the other information recited in this Amendment, a person skilled in the art would further recognize that the inventors understood their invention to include the concept of the customs invoice information including information generated based on customs requirements of the country for which the brokering party is brokering the goods.

15 C. Claims 17-20, 23 and 24 Meet the Written Description Requirement

The specification further describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had 20 possession of the claimed invention of claims 17-20, 23 and 24. The applicants therefore respectfully traverse that objection and the related rejection. More particularly, the applicants traverse that the specification does not contain a written description that the customs invoice information includes a description of goods or a classification of goods consistent with requirements or best practices of the country for which the brokering party 25 is brokering the goods; or a written description that the customs invoice information is generated based upon the country, or pertains to preferred business practices of customs submission in the country, for which the brokering party is brokering the goods.

30 The specification explicitly recites that "[o]ne typically important import issue is the handling of imported goods through customs, whether by the client themselves or a third party customs broker. Central to the import process is the proper description and classification of goods. Also, of high importance are the consistent description and classification of goods. These are both important for legal compliance with import laws in

most jurisdictions. . . . Also, various formats and preferred business practices should be adhered to, depending on the jurisdiction." "[T]he import functional engine preferably includes one or more service engines that generate, or assist in the generation of, customs invoices that consistently and accurately describe the products. Preferably these service engines take into account both the best practices and the legal requirements of each country". [See, substitute specification, page 37, line 24, to page 38, line 11.]

From the above recited information, in total with the other information recited in this Amendment, a person skilled in the art would recognize that the inventors understood their invention to include the concept that the customs invoice information includes a description of goods and a classification of goods that is consistent with the requirements and best practices of the country for which the brokering party is brokering the goods, and based upon the country, and its preferred business practices.

Moreover, the specification recites that "[u]sing the product number and the country code as the query, the server makes a call to the product regulatory reference server, which returns a classification number, *i.e.*, a local HTS number, for the product, . . . and an acceptable description of the goods. Each product number has a unique ECCN. The local HTS number, the ECCN, and the acceptable description of the goods are returned and incorporated into the billing file. The server creates a customs invoice for the particular country using the billing file and creates an encrypted electronic file of the customs invoice. The server also creates an envelope containing the encrypted electronic file and serializes the envelope. The encrypted electronic file is stored in the database and the envelope is transmitted via email to an email address that is accessed by the customs broker." [See, substitute specification, page 39, lines 1-11.]

Based on all the information cited above with respect to claims 17-20, 23 and 24, in total with the other information recited in this Amendment, a person skilled in the art would further recognize that the inventors understood their invention to include the concept of the a server that creates an invoice, including a description and classification of goods based on the legal requirements and best practices of a particular country, and sends that customs invoice information to a customs broker for that country.

D. Claims 21, 22, 25 and 26 Meet the Written Description Requirement

The specification further describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention of claims 21, 22, 25 and 26. The applicants therefore respectfully traverse that objection and the related rejection. More particularly, the applicants traverse that the specification does not contain a written description that the customs invoice information is generated to be consistent with prior shipments of the buyer or seller; or that the customs invoice information includes information based upon prior transactions by the buyer or seller.

The specification explicitly recites that "[o]ne typically important import issue is the handling of imported goods through customs, whether by the client themselves or a third party customs broker. . . . Also, of high importance are the consistent description and classification of goods. These are both important for legal compliance with import laws in most jurisdictions." "[T]he import functional engine preferably includes one or more service engines that generate, or assist in the generation of, customs invoices that consistently and accurately describe the products." [See, substitute specification, page 37, line 24, to page 38, line 11.]

A person skilled in the art would recognize that, depending on shipping terms, either a buyer or a seller could be the client (of the international-trade server) that is responsible for passing the goods through customs. This is recognized in the specification, which states that "customs brokers typically act as the buyer's agent (or possibly the seller's agent) with the local customs service." [See, substitute specification, page 22, lines 19-20.]

From the above recited information, in total with the other information recited in this Amendment, a person skilled in the art would recognize that the description and classification of goods would necessarily have to be consistent with prior shipments of the client, regardless of whether the client was the buyer or the seller. Therefore, a person skilled in the art would recognize that the inventors understood their invention to include the concept that the customs invoice information is generated to be consistent with, and

therefore includes information based upon, prior shipments of either the buyer or the seller, depending on the shipping terms.

E. Claims 27 and 28 Meet the Written Description Requirement

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The specification further describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention of claims 27 and 28. The applicants therefore respectfully traverse that objection and the related rejection. More particularly, the 10 applicants traverse that the specification does not contain a written description that "the customs invoice information includes information specifying duties to be paid", or that "the duty-payment information includes information regarding an assist."

The specification explicitly recites that "[i]n cases where the buying entity 15 provides parts across country borders to the selling entity for the manufacture of the goods, various options are available to the buyer to properly pay the duties on the re-import of the provided parts. This is called an "assist." When the international-trade server actually conducts the transactions, it tracks the parts, and uses the information (under the buyer's preferred "assist" accounting methods) in generating customs documents for the importation of the goods into the buyer's destination country." [See, 20 substitute specification, page 19, lines 17-23.]

From the above-recited information, in total with the other information recited in this Amendment, a person skilled in the art would recognize that the information on the 25 reimportation of goods, which is information specifying duties to be paid regarding an assist, is used in generating customs documents, and therefore causes the customs documents to contain information on the duties to be paid based on that assist. Therefore, a person skilled in the art would recognize that the inventors understood their invention to include the concept that the customs invoice information includes information specifying 30 duties to be paid regarding an assist.

F. Claims 32 and 33 Meet the Written Description Requirement

The specification further describes subject matter that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention of claims 32 and 33. The applicants therefore respectfully traverse that objection and the related rejection. More particularly, the applicants traverse that the specification does not contain a written description of "customs invoice information, which is additional to information on documents typically in transit with purchased goods, for a second country that is different than the first country, and further comprising transmitting the customs invoice information for the second country to a brokering party for the second country"; and "wherein the brokering party for the first country is different from the brokering party for the second country."

In the Background of the Invention, the specification identifies as a problem that "The goods can be subject to export license requirements, import duties, and customs regulations. These issues can arise with each international border crossed by the goods, even goods that are simply in transit through a jurisdiction." "A typical commercial shipment could involve nine different participants, 20 separate documents, 35 customer-vendor interactions and four modes of transport. It could require weeks or months to complete, and can cross several international borders." [See, substitute specification, page 1, lines 16-19, and page 3, lines 1-4.]

In describing features of the invention, the Detailed Description recites that "[t]he international-trade server also uses appropriate module to generate customs instructions, including a customs invoice, and transmits these customs instructions 65 to the appropriate brokering party or parties. Typically this brokering party will be a customs broker, as discussed above. However, in some cases, actual parties to the transaction will act as their own customs broker, as may be required by national law. Both situations can occur for a single transaction, as the goods might cross a number of international borders. The brokering party or parties broker the goods 64 when they reach appropriate customs stations." [See, substitute specification, page 16, lines 7-14.]

The Background therefore makes clear that different issues of customs regulations occur at each border crossing, while the Detailed Description makes clear that numerous brokering parties at different borders will each receive customs instructions. From this, and considering the information discussed above with regard to claim 1, a person skilled in the art would recognize that the inventors understood their invention to include the concept of the transmission of customs invoice information to a plurality of brokering parties at different borders, separately from the documents accompanying the goods, and including information additional to information on documents typically in transit with purchased goods.

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G. The Office Action Fails to Establish a *Prima Facie* Case, Under § 112, the Written Description Requirement, of Claims 1-9 and 16-34

15 For the reasons recited above, the Specification supports the subject matter set forth in the claims, and claims 1 to 9 and 16 to 34 are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Therefore, the Office Action fails to establish a *prima facie* case under § 112, the written description requirement, with respect to claims 1-9 and 16-33. Accordingly, the rejections of claims 20 1-9 and 16-33 under 37 U.S.C. § 112 are improper, and the applicants respectfully request they be withdrawn.

IV. REJECTION UNDER 35 U.S.C. 103(a)

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The Office Action dated September 27, 2004 does not address a feature common to all the claims (i.e., that the customs invoice information is "additional to information on documents typically in transit with purchased goods"). In the telephonic interview of February 3, 2005, the examiner confirmed that these arguments were not considered, 30 explaining that it was unnecessary to consider the feature because all of the claims were rejected over the addition of that feature based on the written description requirement.

The following remarks are similar to those asserted in the Amendment filed May 27, 2004. Nevertheless, the present Amendment is fully responsive to the recent Office Action, as the feature being discussed below has not yet been considered in an office action.

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A. The Cited Reference Fails to Teach or Suggest All the Claim Limitations Recited in Independent Claims 1 and 34

The prior amendment of independent claim 1 in the Amendment filed May 27, 10 2004, clarified the meaning of “customs invoice information” to be information that is “additional to information on documents typically in transit with purchased goods.” The applicants note that issues with customs regulations arise with each international border crossed by the goods (see, page 1, lines 16-19). Under the present invention, customs invoice information (i.e., information over and above the information typically received 15 with shipped documents) is generated and transmitted to a brokering agent (e.g., a customs broker) for a given country. Using this customs invoice information, rather than their own discretion, the brokering agent should be able to file customs invoices reciting consistent customs invoice information. This meaning of the phrase “customs invoice information” comports with its use throughout the specification. [See, page 37, line 23 to page 38, line 20 18, and the discussion of claim 1 under the § 112 rejection under the written description requirement.

The customs invoice information might be generated using information provided in 25 commercial documents. It also might be generated using information regarding past transactions, and/or using information on the taxable basis of the goods (e.g., such as when an assist has occurred). In some cases, there might be similarity between some types of commercial document information and similar types of customs invoice information. Nevertheless, a single set of commercial documents shipped with the goods will produce different customs invoice information for different countries, such as due to 30 differences in classification numbers, regulations, and differences in rulings on the particular products or parties involved (all of which can vary from country to country).

Thus, the shipping documents, do not comprise a customs invoice. For a single shipment of goods passing through multiple countries, the customs invoice information can vary from country to country. Likewise, for identical shipments of identical goods in to a single country, the customs invoice information can vary from party to party (e.g., 5 buyer to buyer), but should generally be consistent for all identical shipments from a given seller to a given buyer unless the country's laws or rulings on the goods or parties have changed.

For example, legal compliance in a given country can often require the consistent 10 description and classification of goods when a buyer imports the same goods on different occasions. The documents shipped with purchased goods typically identify the goods by names that the seller prefers to use for the goods. Under prior procedures, brokering agents review these documents, and then select a customs description and classification based on their own opinions and experiences as to what descriptions and classifications 15 are appropriate. For any given shipment, the resulting customs description could be similar to, or very different from, the sellers preferred name of the goods.

Under this example, different sellers might use different names for the same goods, causing unacceptable variations in the customs description and classification. 20 Furthermore, for a given set of commercial document information, the resulting customs description and classification can vary not only from one customs brokerage to another, but also from individual broker to individual broker within a customs brokerage, and even from shipment to shipment for a given broker. As a result, due to differences such as using different sellers or different brokering agents, a buyer might end up having filed 25 different customs descriptions and classifications on various shipments of the same type of goods. Furthermore, because brokering agents might not be informed about a particular country's prior ruling pertaining to the buyer, incorrect customs descriptions or classifications might be used in filing the customs invoice.

30 In an embodiment described in the application, the service engine that generates customs invoice information provides classification information, such as from a Regulatory Classification System, description information, assist information, duty information, preferred practice information, packaging information, health and safety

information, environmental information, and/or other customs information specific to the buyer, the seller, and/or the goods, as required by the particular customs authorities. [See, page 19, lines 17 to 23; pg. 37, line 22 to page 39, line 26; and page 42, line 28 to page 43, line 2.]

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Pool, fails to disclose the action of transmitting 'customs invoice information, which is additional to information on documents typically in transit with purchased goods, for a first country' as recited in the claims and used in the specification, to a brokering party.

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B. The Office Action Fails to Establish a *Prima Facie* Case of Obviousness

For the reasons recited above, the cited art fails to teach or suggest the features explicitly recited in independent claims 1 and 34, and incorporated into dependent claims 15 2-9 and 16-33. Therefore, the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1-9 and 16-33. Accordingly, the rejections of claims 1-9 and 16-33 under 37 U.S.C. § 103(a) are improper, and the applicants respectfully request they be withdrawn.

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V. CONCLUSION

In view of the foregoing, the applicants respectfully request that a timely Notice of Allowance be issued in this case.

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Respectfully submitted,

Le et al.

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